

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

**Status of the Claims**

Claims 1-25 are pending; no claims are newly added, amended, or canceled herewith.

**Summary of the Office Action**

In the outstanding Office Action, Claims 1-3, 7-9, 13-15, and 19-25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Matoba et al. (U.S. Pat. No. 6,392,669, hereafter Matoba) and Pietropaolo et al. (U.S. Pat. No. 6,351,765, hereafter Pietropaolo); Claims 4, 5, 10, 11, 16, and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Matoba, Pietropaolo, and Protheroe et al. (U.S. Pat. No. 6,414,686, hereafter Protheroe); and Claims 6, 12, and 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Matoba, Pietropaolo, and Crow et al. (U.S. Pat. No. 6,538,665, hereafter Crow).

**Rejections under 35 U.S.C. § 103**

With regard to the rejection of Claims 1-3, 7-9, 13-15, and 19-25 under 35 U.S.C. § 103(a) as unpatentable over Matoba in view of Pietropaolo, that rejection is respectfully traversed.

In the past, scheduling wizards enabled users to set a reservation for recording by inputting settings such as a channel, start time, and end time of a program desired to be reserved for future recording using setting screens that were sequentially displayed. However, the reservation wizard had the drawback that it was difficult for the user to tell when the reservation process would be completed. Additionally, once a reservation had been made, it was very difficult to edit the reservation.<sup>1</sup> In light of these difficulties, the Applicants developed the present invention as recited, for example, in Claim 1.

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<sup>1</sup> Specification, pages 1-2.

To this end, Claim 1 recites, in part,

a reservation registration apparatus for performing a registration process of causing an arbitrary reservation subject to be manipulated at a specified starting time, said apparatus comprising:

display controlling means for displaying on a display screen a plurality of reservation subject icons representing said reservation subjects and a time base display area of a calendar for performing said reservation registration ...

selection means for receiving input media for said arbitrary reservation subject, said input media having at least one component, said selection means operating to select and mix formats of said at least one component of said media ....

The outstanding Office Action admits at page 3 that Matoba does not disclose or suggest these features. The outstanding Office Action then alleges that Pietropaolo remedies the admitted deficiencies of Matoba.

However, it is respectfully submitted that the outstanding Office Action has not provided a *prima facie* case of obviousness. As set forth in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). Moreover, although a prior art device might be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so. Id. at 682. In this case, it is respectfully submitted that the applied references are not in an analogous field of art and there is no motivation in the teachings of either reference to support the proposed modification set forth in the outstanding Office Action.

Matoba relates to a schedule management system and method for displaying, managing, and changing a schedule and a recording medium for storing the same. In more detail, Matoba is directed toward common scheduling so that individuals might use a conference room, attend a customer call, an external education course, a business trip, a work

task, or the like.<sup>2</sup> As this description indicates, Matoba is not in any way related to the reservation of recording materials or media. In other words, the field of art of Matoba relates to scheduling business meetings or conference rooms.

Because Matoba is not in an analogous field of art, it is unclear how one of ordinary skill in the art, reading Matoba, would have been motivated to modify the teachings therein to develop the solution identified by the present Applicants. Certainly, the Office Action does not provide any reasoning to support the alleged obviousness of the combination.

The secondary reference, Pietropaolo, relates to a non-linear video editing system. Pietropaolo also does not in any way relate to scheduling a reservation of a recording. Rather, Pietropaolo relates to the editing of video clips. Therefore, it is also unclear how one of ordinary skill in the art, reviewing the disclosure of Pietropaolo, would have found it obvious to modify the teachings of Pietropaolo to include selected features of Matoba, as proposed by the outstanding Office Action. Again, the Office Action has not cited any motivation within Pietropaolo to support the combination.

Simply put, as neither Pietropaolo nor Matoba relates to scheduling the recording or manipulation of input media and as neither reference is in any way directed to solving difficulties in the scheduling of input media, it is respectfully submitted that there is no motivation in the teachings of either reference to support the applied combination. Certainly, the outstanding Office Action has not cited to any teaching in either reference to provide the required motivation. As a result, it is respectfully submitted that the outstanding Office Action has violated the requirements set forth in MPEP § 2143.01 and has not provided a *prima facie* case of obviousness.

Moreover, the proposed modification cannot change the principle of operation of a reference. *See, e.g.*, MPEP § 2143.01. In other words, if the proposed modification or

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<sup>2</sup> Matoba, col. 1, lines 16-19.

combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810 (CCPA 1959).

Matoba, as noted above, is directed to managing schedules for conference rooms and the like. Because Matoba is not in any way directed to the recordation of electronic media, as recited in the claims, there is no provision in the teachings of Matoba for the recordation of electronic media. As a result, the modification proposed in the outstanding Office Action would certainly change the principle of operation of Matoba, as it would require the incorporation of recording media, a media input, as well as a display for the recorded media.

Similarly, Pietropaolo relates to a non-linear video editing system. Pietropaolo does not contemplate using a calendar to schedule recordings. In fact, Pietropaolo describes that the non-linear video editor is connected to selectively access decimated video segments and source video segments from the digital database system.<sup>3</sup> Pietropaolo further describes that the non-linear video editor is capable of using the decimated video segments during editing of a video program and accessing the source video segments to produce the program at a different quality than the selected video.<sup>4</sup>

As this description indicates, Pietropaolo requires that a media segment is previously recorded before it may be accessed by the editing system of Pietropaolo. Accordingly, to modify the teachings of Pietropaolo to account for a reservation of a recording and to allege that Pietropaolo teaches controlling the beginning and ending times based on the user's placement of the media in the timeline, as asserted at page 3 of the outstanding Office Action, changes the principle of operation of Pietropaolo.

Thus, as the outstanding Office Action has violated the requirements set forth in MPEP § 2143.03, it is respectfully submitted that the outstanding Office Action has not

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<sup>3</sup> Pietropaolo, Abstract.

<sup>4</sup> Id.

provided a *prima facie* case of obviousness. According, it is respectfully requested that the outstanding rejection of Claims 1-3, 7-9, 13-15, and 19-25 be withdrawn.

With regard to the rejection of Claims 4, 5, 10, 11, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over Matoba, Pietropaolo and Protheroe, that rejection is also respectfully traversed.

As noted above, the applied combination of Matoba and Pietropaolo fails to provide a *prima facie* case of obviousness with respect to the independent claims. It is respectfully submitted that Protheroe does not remedy the deficiencies above-noted with regard to the combination of Matoba and Pietropaolo.

Even assuming, *arguendo*, that Protheroe remedied the above-identified deficiencies of Matoba and Pietropaolo, it is respectfully submitted that there is no motivation in the teachings of Protheroe to support the alleged obviousness of the combination with Matoba and Pietropaolo. Certainly, the outstanding Office Action does not cite to any teachings within Protheroe to support the applied combination. Consequently, it is respectfully submitted that the applied combination of Matoba, Pietropaolo, and Protheroe is the result of hindsight reconstruction in view of the teachings in the present specification, and is improper.

Thus, as the outstanding Office Action has not provided a *prima facie* case of obviousness with respect to Claims 4, 5, 10, 11, 16, and 17, it is respectfully requested that this rejection be withdrawn.

Likewise, the rejection of Claims 6, 12, and 18 as unpatentable under 35 U.S.C. § 103(a) over Matoba, Pietropaolo, and Crow is respectfully traversed.

Crow does not remedy the above-identified deficiencies in the combination of Matoba and Pietropaolo. Even if Crow were assumed to remedy these deficiencies, it is respectfully submitted that there is no motivation in the teachings of Crow to support the applied combination with Matoba and Pietropaolo. As a result, it is respectfully submitted that the

combination of Matoba, Pietropaolo, and Crow is the result of hindsight reconstruction, and is improper.

Therefore, because the outstanding Office Action has also failed to provide a *prima facie* case of obviousness with respect to the Claims 6, 12, and 18, it is respectfully requested that this rejection be withdrawn.

Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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